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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YEN-KUANG CHEN, WILLIAM W. MACY JR.,
MATTHEW HOLLIMAN, ERIC L. DEBES,
and MINERVA M. YOUNG

Appeal 2009-004091
Application 10/612,542¹
Technology Center 2100

Decided: April 27, 2010

Before LEE E. BARRETT, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed July 1, 2003. The real party in interest is Intel Corp. (Br. 3.)

STATEMENT OF THE CASE

The Appellants appeal the Examiner's rejection of claims 24-29 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' Invention

Appellants invented a method for bitstream buffer manipulation utilizing an SIMD (single instruction multiple data) merge instruction, the method embodied in a machine-readable medium. (Spec. ¶¶ [0004], [0025], [0029].)²

Representative Claim

Independent claim 24 further illustrates the invention. It reads as follows:

24. An article comprising a tangible machine readable medium that stores a program, said program being executable by a machine to perform a method comprising:

determining whether any unprocessed data bits for a partial variable length symbol exist in a first data block; and

performing a shift merge operation responsive to a shift merge instruction specifying the first data block, a second data block and a shift count, the shift merge operation to merge said unprocessed data bits from said first data block with said second data block, wherein a merged data block is formed.

² We refer to Appellants' Specification ("Spec.") and Appeal Brief ("Br.") filed September 11, 2007. We also refer to the Examiner's Answer ("Ans.") mailed October 12, 2007.

Rejection on Appeal

The Examiner rejects claims 24-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.³

ISSUE

Based on Appellants' contentions, as well as the findings and conclusions of the Examiner, the pivotal issue before us is as follows.

Does the Examiner err in rejecting claims 24-29 under 35 U.S.C. § 101? The issue turns on whether the claimed subject matter is statutory subject matter.

³ We note some confusion as to the actual rejection(s) on appeal. The Examiner initially rejected claims 1-39 under 35 U.S.C. § 102(e), claims 1-29 under 35 U.S.C. § 101, and claims 6-8, 10, 12-14, 22, 23, 28, and 36-39 under 35 U.S.C. § 112 (second paragraph). (Office Action mailed August 16, 2006 at pages 2-4.) The Examiner renewed the rejection of claims 1-29 under 35 U.S.C. § 101, but did not renew or withdraw the other rejections (under 35 U.S.C. §§ 102(e) and 112) in the Final Rejection. (Office Action mailed March 26, 2007 ("Final Rejection") at page 2.) Appellants assert that they appeal claims 1-29 that stand rejected under 35 U.S.C. § 101, and that claims 30-39 are allowed. (Br. 3.) The Examiner agrees with Appellants' asserted grounds of rejection for review, withdraws the rejection of claims 1-23 under 35 U.S.C. § 101, and states that claims 1-23 and 30-39 are allowed. (Ans. 2.) Thus, it appears the Appellants and Examiner agree that claims 24-29 are rejected under 35 U.S.C. § 101, and that claims 1-23 and 30-39 are in condition for allowance. Accordingly, we treat claims 24-29 as the claims under review, and treat the Examiner's failure to properly notice the withdrawn rejections and allowable claims as harmless error.

FINDINGS OF FACT (FF)

Appellants' Specification

1. Appellants' Specification defines a machine-readable (computer-readable) medium:

[A] machine-readable medium may include any mechanism for storing or transmitting information in a form readable by a machine (e.g., a computer), but is not limited to, . . . a transmission over the Internet, electrical, optical, acoustical or other forms of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.) or the like. Accordingly, the computer-readable medium includes any type of media/machine-readable medium suitable for storing or transmitting electronic instructions or information in a form readable by a machine (e.g., a computer). Moreover, the present invention may also be downloaded as a computer program product. As such, the program may be transferred from a remote computer (e.g., a server) to a requesting computer (e.g., a client). The transfer of the program may be by way of electrical, optical, acoustical, or other forms of data signals embodied in a carrier wave or other propagation medium via a communication link (e.g., a modem, network connection or the like).

(Spec. ¶ [0029].)

PRINCIPLES OF LAW

Burden on Appeal

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for any rejection in order to provide an applicant with notice of the reasons why the applicant is not entitled to a patent on the claim scope sought. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir.

1984); *Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (Precedential). An appellant has the opportunity on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998), *overruled in part on other grounds*, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 422 (2007)); *Ex Parte Frye*, 94 USPQ2d at 1075.

Statutory Subject Matter

Our reviewing court has recently held that transitory, propagating signals, such as carrier waves, are not within any of the four statutory categories (process, machine, manufacture or composition of matter). Therefore, a claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

ANALYSIS

Appellants contend that independent claim 24 and dependent claims 25-29 are directed to statutory subject matter (Br. 7-11); and specifically, that the claims constitute "statutory . . . articles and apparatus" that are "new and useful" (Br. 9). The Examiner finds that Appellants' claims 24-29 recite a "machine readable medium," defined in Appellants' Specification (at paragraphs [0028]-[0030]), as "including a transmission medium which may be a carrier wave." (Ans. 3.) The Examiner also finds that the term

“tangible” is not defined by Appellants’ Specification, and means “capable of being perceived especially by the sense of touch.” (Ans. 3.) Thus, the Examiner finds that a “carrier wave is clearly capable of being perceived,” and that Appellants’ claims “read on a transmission medium which may be carrier waves,” and “fail[] to fall within any of the statutory categories.” (Ans. 3, 4; *see* Final Rejection 2.) Accordingly, we decide the question of whether the claimed subject matter is statutory.

Appellants’ independent claim 24 (and dependent claims 25-29) recites a “tangible machine readable medium that stores a program.” We agree with the Appellants that their tangible machine readable medium, as disclosed by their Specification, does not include non-statutory subject matter – i.e., signals. Appellants’ Specification distinguishes between storing and transmitting or transferring the program information. (FF 1.) Although Appellants’ Specification describes machine readable media as including “propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.) or the like” (FF 1); Appellants claim a “tangible machine readable medium that stores a program.” We do not view a signal as a tangible medium capable of storing (as opposed to transmitting) a program. Thus, we find that Appellants’ claimed tangible machine readable media does not implicate a non-statutory carrier wave or a signal modulated by a carrier over a transmission medium. *See In re Nuijten*, 500 F.3d at 1357; *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010). Appellants’ claims 24-29 do not encompass the use of a transitory, propagating computer data signal embodied in a carrier wave to transfer information. It follows that claims 24-29 are directed to statutory subject matter. Accordingly, Appellants have persuaded us to find

error in the Examiner's 35 U.S.C. § 101 rejection of Appellants' claims 24-29, and we reverse the Examiner's § 101 rejection of these claims.

CONCLUSION OF LAW

On the record before us, we find the Examiner erred in rejecting claims 24-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

We reverse the Examiner's rejection of claims 24-29 under 35 U.S.C. § 101.

REVERSED

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